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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/905,156      | 07/13/2001  | Robert S. Whitehouse | 3130-002-02         | 2730             |

7590                    07/23/2002

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[REDACTED] EXAMINER

SHORT, PATRICIA A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1712     |              |

DATE MAILED: 07/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|                 |                      |      |
|-----------------|----------------------|------|
| Application No. | 09/905/56 Whitehouse |      |
| Examiner        | Shurt                |      |
|                 | Group Art Unit       | 1712 |

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### **Status**

- Responsive to communication(s) filed on \_\_\_\_\_
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### **Disposition of Claims**

- Claim(s) 1 - 25 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1 - 25 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### **Application Papers**

- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### **Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All  Some\*  None of the:
  - Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### **Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by compounds having at least two hydroxyl containing terminal groups with different functionalities. If the terminal groups are hydroxyl groups, how can they be different functionalities? What constitutes different functionalities and where are they located?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-12, 14, 15 and 17-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marans. The reference teaches

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polyurethane foam prepared by reacting an isocyanate with a compound containing an hydroxyalkanoate. See col. 2, lines 60-68 and example 6. Use of the specific hydroxyalkanoates required in the claims is anticipated by or would have been obvious over the teachings of the reference.

Claims 1, 8, 9-18, 17-20, 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koleske. The reference teaches a polyurethane coating composition prepared by reacting an isocyanate with a compound containing an hydroxyalkanoate. See examples 16 where the Polyol F and ester diol ethoxylate are hydroxyalkanoates. The language thermally decomposable or biodegradable hydroxyalkanoate does not distinguish over the Polyol F and ester diol ethoxylate used in the example.

Claims 1-13 and 16-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Neuenschwander. The reference teaches a polyurethane prepared by reacting an isocyanate with a compound containing an hydroxyalkanoate. See col. 2, line 9 through col. 7, lines 53. Use of the specific hydroxyalkanoates required in the claims is anticipated by or would have been obvious over the teachings of the reference.

Claims 1-20 and 22-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamaguchi. The reference teaches a polyurethane prepared by reacting an isocyanate with a compound containing an hydroxyalkanoate. See the claims. Use of the specific hydroxyalkanoates required in the claims is anticipated by or would have been obvious over the teachings of the reference.

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Claims 1-3, 8-13, 17-20, 24 and 25 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of WO '510 and Kim. Kim is an English equivalent of WO '510. Each of the references teaches a polyurethane prepared by reacting an isocyanate with a compound containing an hydroxyalkanoate. See col. 2, line 12 through col. 3, line 45 of Kim and page 3, line 8 through page 4, line 35 of WO '510. Use of the specific hydroxyalkanoates required in the claims is anticipated by or would have been obvious over the teachings of the reference.

Claims 1-25 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of WO '527 and Lee. Lee is an English equivalent of WO '527. Each of the references teaches a polyurethane prepared by reacting an isocyanate with a compound containing an hydroxyalkanoate. See col. 6, line 49 through col. 7, line 20, col. 8, lines 33-61 and col 18, line 49 through col. 19, line 13 of Lee and page 9, line 22 through page 10, line 27, page 12, line 24 through page 13, line 23 and page 31, line 9 through page 32, line 6. Use of the specific hydroxyalkanoates required in the claims is anticipated by or would have been obvious over the teachings of the reference.

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July 17, 2002

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